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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,885	08/17/2001	Bruno Tisserand	066829-5064	5990
9629 7590 11/23/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER DIVECHA, KAMAL B	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 11/23/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/913,885

Applicant(s)

TISSERAND ET AL.

Examiner

KAMAL B. DIVECHA

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Claims 1-7, 10-16 are pending in this application.

Claims 8-9 were previously withdrawn.

**Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 20, 2007 has been entered.

**Response to Arguments**

Applicant's arguments filed in association with RCE with respect to claims 1-7 and 10-16 have been considered but are moot in view of the new ground(s) of rejection, as necessitated by the inclusion of "without establishing call" into the independent claims.

**Specification**

Examiner acknowledges applicant's understanding of preference and requirements of the arrangement of the specification, based on MPEP 608.01(a).

The inclusion of the proper headings and sections in the disclosure presents the application in more structured form.

As such, the objection is maintained.

The disclosure is objected to because the specification does not include one or more sections indicated below.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

**Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.**
  - (1) Field of the Invention.**

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(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### **Claim Rejections - 35 USC § 112**

The 35 U.S.C. 112, second paragraph rejection presented in the previous office action is withdrawn.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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1. Claims 1-3, 6-7, 10-12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1).

As per claim 1, Lindsay discloses a method of sending a signaling messages through a transmission network (fig. 1-2), comprising:

- activating a request to set up a call channel (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- performing a signaling stage comprising sending said signaling message (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1); and
- terminating the setting up of the call channel once the signaling message has been communicated without establishing the call (col. 24 L30-50, col. 27 L36 to col. 28 L26, col. 30 L66 to col. 31 L24: terminating the call during and/or prior of the establishment of the call channel).

However, Lindsay does not disclose the process of placing a user message (i.e. information) in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field.

Ranta explicitly discloses placing information in a spare field of a signaling message for setting up the channel (note according to applicant specification, page 4, lines 15-24: the invention utilizes GSM standard 04.18) the signaling message includes an identifier (a parameter) to indicate the presence of said spare field (col. 2 L41-58, col. 3 L63 to col. 4 L67, col. 5 L49-67, fig. 2).

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Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to place information and/or user message in a spare field of signaling message.

One of ordinary skilled in the art would have been motivated because it would have allowed the system to transmit information in an unoccupied parts of the signaling message (Ranta, col. 2 L13-25).

As per claim 2, Lindsay discloses the process wherein the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claim 3, Lindsay discloses the process wherein a user is authorized to access the dedicated memory by means of specific commands (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28: obviously it requires the commands to access the memory).

As per claim 6, Lindsay does not disclose the process wherein the size of the user message is limited to 35 eight-bit bytes at maximum (i.e. the user message is less than 35 bytes and/or in the range of 0-35 bytes).

Ranta discloses the process wherein the spare field (i.e. the user message that can be inserted into the spare field) is limited to 17 bytes (col. 3 L64 to col. 4 L10: i.e. 17 bytes is in the range of 0-35 bytes).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to limit the size to 35 bytes at maximum.

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One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 1.

As per claim 7, Lindsay discloses the process wherein the user message is communicated in an enciphered form (i.e. encrypted, col. 20 L1-40).

As per claim 11, Lindsay discloses the process wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claims 10, 12 and 15-16, they do not teach or further define over the limitations in claims 1-3, 6-7 and 11. Therefore claims 10, 12 and 15-16 are rejected for the same reasons as set forth in claims 1-3, 6-7 and 11.

2. Claims 4-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1), and further in view of Miller, II (hereinafter Miller, US 5,600,707).

As per claim 4, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and the transmission network is a mobile telephone network (fig. 2, col. 5 L50 to col. 6 L35, fig. 2A, col. 9 L56 to col. 10 L43: mobile telephone network).

However, Lindsay does not disclose the process wherein the mobile telephone is used as modem.

Miller explicitly discloses the process and apparatus, i.e. mobile device that can be used as a modem (col. 1 L30-55, col. 2 L26-61, fig. 1).



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Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to use mobile telephone as a modem.

One of ordinary skilled in the art would have been motivated because it would have enabled communications (Miller, col. 1 L31-65).

As per claim 5, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and using ISDN as the transmission network (col. 6 L60-67).

However, Lindsay does not disclose the process wherein the dedicated memory is in an ISDN-type modem.

Miller explicitly discloses an ISDN-type modem (fig. 1, col. 1 L31-65, col. 2 L62 to col. 3 L22).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to include the dedicated memory in an ISDN-type modem.

One of ordinary skilled in the art would have been motivated because it would have allowed data communications (Miller, col. 1 L31-65).

As per claims 13-14, they do not teach or further define over the limitations in claims 4-5. Therefore, claims 13-14 are rejected for the same reasons as set forth in claims 4-5.

**Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pettersson et al., US 6,304,595 B1: Mobile Telephone Modems.
- b. Hameleers et al., US 6,377,799 B1: Interworking function in an internet protocol based radio telecommunications network.
- c. Schiefer et al., US 5,884,175: Handover following in a mobile radio system.
- d. Clarke et al., US 5,550,914: Communications Signalling network apparatus.
- e. Rosenthal et al., U. S. Patent No. 5,737,701: Automatic Authentication System.
- f. Wallenius, U. S. Patent No. 6,466,786 B1: Call setup in Mobile Communications.

**Conclusion**

This Action is made Non-Final.

Please Note: The teachings of the prior art shall not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner, in order to move prosecution forward.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal Divecha/

Kamal Divecha  
Art Unit 2151  
November 15, 2007.

  
**JOHN FOLLANSBEE**  
**SUPERVISORY PATENT EXAMINER**  
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